

### **REMARKS**

Claims 3, 4, 6, and 23-25 are now pending in the application. Claim 23 is amended herein. Support for the amendments and additions can be found throughout the application, drawings, and claims as originally filed and, as such, no new matter has been presented. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 24 and 25 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

Claim 24 recites "...wherein said blade is secured relative to said handle in each of a lengthwise direction of said blade, a widthwise direction of said blade, and a depthwise direction of said blade by a positive engagement of said blade with one or more of said handle and said blade mounting screw." Referring to Figure 2 and paragraph [0025] of the present application, when the blade 14 is attached to the handle 12 in the vertical orientation, the blade 14 is secured from being displaced relative to the handle 12 in the lengthwise direction of the blade 14 through engagement with the screw 38 and the rear sidewall of the blade mounting portion of the handle 12. Furthermore, the blade 14 is secured from translating across the blade mounting portion 24 in a widthwise direction of the blade 14 through engagement with the opposing top and bottom sidewalls of the blade mounting portion 24 and through engagement of the slot 34 of the blade 14 with the key 30 of the handle 12. Additionally, the blade 14 is

secured from moving away from the handle 12 in a depthwise direction (the direction along the thickness of the blade 14) as it is sandwiched between the head of the screw 38 and the blade mounting portion 24. Referring to Figure 3 and paragraphs [0026]-[0027] of the present application, when the blade 14 is attached to the handle 12 in the horizontal or cross cut orientation, the blade 14 is secured in lengthwise and depthwise directions by the fastener 46 and in the widthwise direction by the key 42 in a similar manner as described with regard to the vertical orientation of blade 14. Therefore, Applicants submit that the subject matter of claim 24 is more than adequately supported in the present application such that one of ordinary skill in the art would conclude that Applicants had possession of the claimed subject matter. Accordingly, for at least these reasons, Applicants submit that claim 24 is in conformance with 35 U.S.C. § 112, first paragraph.

Claim 25 depends on claim 24. Therefore, for at least the same reasons, Applicants submit that claim 25 is in conformance with 35 U.S.C. § 112, first paragraph.

Applicants, therefore, respectfully request reconsideration and withdrawal of this rejection.

Claims 24 and 25 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

As described above, claim 24 is directed to the feature of the present application that, at each of the two mounting locations of the blade, the blade is positively secured to the handle in each of three defined directions. As Applicants submit that this subject matter is more than adequately supported in the present application, Applicants submit

that a person of ordinary skill in the art having the benefit of reading the present application would completely understand that which is recited in claim 24. Accordingly, for at least these reasons, Applicants submit that claim 24 is in conformance with 35 U.S.C. § 112, second paragraph.

Claim 25 depends on claim 24. Therefore, for at least the same reasons, Applicants submit that claim 25 is in conformance with 35 U.S.C. § 112, second paragraph.

Applicants, therefore, respectfully request reconsideration and withdrawal of this rejection.

#### **REJECTION UNDER 35 U.S.C. § 102**

Claim 23 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Davey (U.S. Pat. No. 2,017,895). This rejection is respectfully traversed.

Claim 23 calls for a hand saw including "...a handle including a hand grip portion and first and second blade mounting portions, said hand grip portion defining an inner surface..." and "...a blade removably mounted to one of said first and second blade mounting portions and extending in a first direction away from said handle..." Claim 23 further recites "...wherein said inner surface of said hand grip portion is **sloped toward said blade** so as to be oriented at an acute angle relative to said first direction..." (emphasis added).

As explained in the previous Response, with reference to paragraphs 3-4 of the present application, the hand saw of the present application provides an improved configuration for flush cutting applications. For example, when the blade is mounted on

the bottom portion of the handle, the inner surface of hand grip portion of the handle is forwardly sloped toward the blade (see, e.g. Figure 1 of the present application). As such, during flush cutting applications (e.g., using the saw on the floor), if a downwardly angled force toward the blade is applied to the handle, the downward component of the force acts to hold the blade flush.

Applicants submit that Davey does not anticipate claim 23. Referring to Section 2131 of the MPEP: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In contrast to the present application, when the blade 11 of Davey is coupled on side C of holding means 12, handle 20 is **sloped away** from the blade 11 (see, e.g., Figure 1 of Davey). As this configuration is opposite the present application, Applicants submit that Davey does not disclose a hand saw having a handle with the configuration specifically recited in claim 23 of the present application. Accordingly, for at least these reasons, Applicants submit that claim 23 is not anticipated by Davey and should be patentable.

Applicants, therefore, respectfully request reconsideration and withdrawal of this rejection.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claims 3, 4, 6, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Davey in view of Applicant's Admitted Prior Art ("AAPA"). This rejection is respectfully traversed.

Claim 3 calls for a hand saw comprising "...a handle including a hand grip portion and first and second blade mounting portions... and a blade adapted to be removably mounted to either of said first and second blade mounting portions..." Claim 3 further recites "...said first and second blade mounting portions each include a screw boss for receiving a blade mounting screw therein..."

Claim 4 calls for a hand saw comprising "...a handle including a hand grip portion and first and second blade mounting portions ... each of said first and second blade mounting portions including a screw boss..." Claim 4 further calls for the hand saw to include "...a blade removably mounted to one of said first and second blade mounting portions; and a blade mounting screw removably engaged with said screw boss of said one of said first and second blade mounting portions so as to couple said blade to said handle..."

The Examiner acknowledges that Davey fails to disclose blade mounting portions each including a screw boss or a screw (see page 4 of the Office Action). The Examiner states, however, that "...it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a boss with the Davey device for the purpose of guiding the fastener..." and that "...it would have been obvious to one of ordinary skill in the art to use an alternative fastener, such as a screw, with the Davey device since such fasteners are known equivalents" (page 4 of the Office Action). The Examiner further states that: "Based on availability of tooling or personal preference, one type of fastener may be preferable to another in certain applications. Surely, Applicant cannot think the instant application is patentable because it uses a screw. Just because the Davey blade 'can be attached and detached without moving parts'

does not mean it would not have been obvious to modify the device with an equivalent fastener that requires a moving part or that the combination teaches away from the reference" (page 5 of the Office Action).

Notwithstanding, Applicants maintain that Davey does not include any motivation or suggestion for the proposed combination; specifically, that Davey teaches away from the proposed combination. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the Examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Additionally, as in the previous Response, Applicants point to section 2145 of the MPEP: "It is improper to combine references where the references teach away from their combination." *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

It is an express object of Davey to provide a device "...wherein the only movable part shall be the blade..." (column 1, lines 7-8 of the Davey reference). Accordingly, Applicants submit that Davey does not suggest the desirability of a modification which includes a moving part and, furthermore, that Davey expressly desires not to include

moving parts. As Davey does not suggest the desirability of the proposed combination and, in fact, teaches away from the proposed combination, Applicants submit that the proposed combination requires the impermissible use of hindsight and, therefore, is improper. Accordingly, for at least these reasons, Applicants submit that claims 3 and 4 are not obvious in view of the references and should be in condition for allowance.

Claims 6 and 24-25 depend on one of claims 3 and 4 and, therefore, for at least the reasons stated above with respect to claims 3 and 4, should also be patentable.

Furthermore, claim 24 recites "...wherein said blade is secured relative to said handle in each of a lengthwise direction of said blade, a widthwise direction of said blade, and a depthwise direction of said blade by a positive engagement of said blade with one or more of said handle and said blade mounting screw." In contrast, as argued in the previous Response, the Davey reference discloses that a frictional engagement of the handle and blade prevents relative angular movement therebetween (see, e.g., column 3, lines 49-51 of the Davey reference). As such, Applicants submit that Davey does not disclose a blade positively secured to a handle in each of three defined directions as specifically recited in claim 24 of the present application. For these additional reasons, Applicants submit that claim 24 should be patentable.

Applicants, therefore, respectfully request reconsideration and withdrawal of these rejections.

## **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request

that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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